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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
0054-0235P	

Application Number	Filed
09/877,006-Conf #1713	June 11, 2001

First Named Inventor: Takeshi MIO et al

Art Unit	Examiner
2621	J. A. Fletcher

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s)
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest.
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record.
  Registration number 29,680
- [ ] attorney or agent acting under 37 CFR 1.34.
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December 11, 2006
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In paragraph 4 of the Action, the Examiner rejects claims 3, 4, 6, 7, and 10-13 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,648,960 to Sakazaki et al. ("Sakazaki"). Applicants respectfully traverse this rejection.

Independent claim 3 defines a program recording/reproducing apparatus for demultiplexing predetermined coded program signals out of streaming signals and recording these program signals. The apparatus includes, *inter alia*, a recording unit that records the respective program packets and a discarded packet count corresponding to the number of packets discarded between two consecutively recorded program packets, wherein the recording unit records one control packet structured in the same format as the program packet as a substitute for a discarded packet, thereby recording a discarded packet count of the packets discarded between two consecutive program packets.

Sakazaki discloses a recording/reproducing apparatus for a data packet stream that includes a data combiner 4 that combines extracted data and information relating to the number of deleted packets. For example, if the input is an MPEG-2 transport data stream, the data combiner reconstructs the transport data stream by assigning two of the extracted data packets to five recorded data packets of a 6 mm digital video tape recorder (VTR) and uses the residual bytes within the sync block to transmit the number of deleted blocks. Therefore, although Sakazaki may disclose recording information relating to the number of deleted packets, nowhere in Sakazaki is there any disclosure of recording a

control packet which includes the discarded packet count in the same format as the program packet as claimed.

In response to Applicant's arguments, the Examiner asserts that although Sakazaki fails to explicitly disclose "the format of the discarded packet count control packet, there is no reason to believe they create a special format for those packets, in light of a lack of disclosure, suggestion, or teaching to that effect." Furthermore, the Examiner asserts that Sakazaki's packet count packet meets the same format as the program packet inasmuch as it is packetized digital bits. The Examiner's assertions are unfounded for the following reasons.

First, nowhere in Sakazaki is there any disclosure or suggestion of recording a control packet, much less a control packet in the same format as the program packet as claimed. Furthermore, despite the Examiner's assertion, there is reason to believe that "they would create a special format" inasmuch as Sakazaki explicitly discloses a special format for the information. More specifically, Sakazaki discloses that "the information relating to the number of deleted packets in a contiguous sequence is arranged within a sync block that contains the two extracted packets that contained the unextracted data packets that were used to generate the information relating to the number of deleted packets...." This sync block is not equivalent to a control packet as claimed.

Second, the mere disclosure of digitized data is not equivalent to disclosing a control packet structured in the same format as a program packet. One skilled in the art would readily appreciate the digitized data can be structured or packetized in numerous formats depending on the various factors.

Furthermore, one skilled in the art would readily appreciate that a control packet is generally not the same as a data packet.

Accordingly, independent claim 3 is patentable over Sakazaki because Sakazaki fails to disclose each and every claimed element.

Independent claim 11 has been amended to include the subject matter of canceled claim 12. Accordingly, claim 11 now defines a method of recording and reproducing predetermined program signal packets from streaming multiplexed signals. The method includes, *inter alia*, recording the extracted predetermined program signal packets and a count of the number of discarded packets between each extracted packet on a recording media, wherein the discarded packet count is recorded in a control packet structured in the same format as a program product. Accordingly, independent claim 11 is not anticipated by Sakazaki for at least the reason that Sakazaki fails to disclose recording the discarded packet count in a control packet structured in the same format as a program packet. (See discussed above with respect to claim 3.)

Claims 4, 7, 10, and 13 variously depend from independent claims 3 and 11. Therefore, claims 4, 7, 10, and 13 are patentable over Sakazaki for at least those reasons presented above with respect to claims 3 and 11. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 4, 7, 10, 11, and 13 under 35 U.S.C. § 102(b).

In paragraph 6 of the Action, the Examiner rejects claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakazaki. Applicants respectfully traverse this rejection.

In rejecting claim 5, the Examiner takes Official Notice that detecting the speed of an input signal for recording and reproduction purposes by means of time management information is notoriously well known. Therefore, the Examiner asserts that it would have been obvious to modify the system of Sakazaki "in order to specify using time management information from the input data stream to determine an output data rate." However, nowhere in the cited reference or the Action is there any evidence or suggestion of the motivation to modify the system of Sakazaki.

As discussed in § 2143.01 of the MPEP, the mere fact that individual elements were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine/modify the cited reference. Therefore, the mere fact that detecting the speed of an input signal by means of time management information may be known in the art is not sufficient in and of itself to render claim 5 unpatentable over Sakazaki. Accordingly, absent some objective reason to modify the teachings of Sakazaki to include the use of time management information as claimed, the rejection of claim 5 is improper.

Furthermore, even if, *arguendo*, one skilled in the art were motivated to modify Sakazaki as suggested by the Examiner, the modification would still fail to render claim 5 unpatentable because the combination fails to disclose each and every claimed element. More specifically, nowhere in Sakazaki is there any disclosure or suggestion of recording the discarded packet count in a control

packet as claimed. Accordingly, Applicants respectfully request reconsideration and withdrawal the rejection of claim 5 under 35 U.S.C. § 103.

In paragraph 7 of the Action, the Examiner rejects claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Sakazaki in view of MPEP-2 by Watkinson ("Watkinson"). Applicants respectfully traverse this rejection.

In rejecting claim 9, the Examiner asserts that it would have been obvious to one skilled in the art to modify Sakazaki "in order to specify the first recording packet being a stream management packet." However, the Examiner provides no motivation for such a modification other than to assert that Watkinson discloses that MPEP-2 transport streams include a management packet. As discussed above, the mere fact that individual elements were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine/modify the cited reference. Therefore, the mere fact that it is known to transmit MPEG-2 data streams with a stream management packet as the first packet is not sufficient in and of itself to render claim 9 unpatentable. Furthermore, Watkinson discloses, *arguendo*, the MPEG-2 transport stream includes a stream management packet as a first packet, not the recorded data stream as claimed. Accordingly, absent some objective reason to modify the teachings of Sakazaki to include the use of stream management packet as claimed, the rejection of claim 9 is improper. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8 and 9 under 35 U.S.C. § 103(a).